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In re Application of :
GAUTHEREON, Pascal J. et al :
U.S. Application No.: 10/562,185 :
PCT No.: PCT/AU04/00859 :
Int. Filing Date: 28 June 2004 :
Priority Date: 26 June 2003 :
Attorney Docket No.: 10022-802 :
For: SYSTEM AND METHOD FOR :
INVESTING FUNDS :

**DECISION ON
PETITION UNDER
37 CFR 1.47(a)**

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(b)" ("Pet.") filed on 22 November 2006 which is treated under 37 CFR 1.47(a).

BACKGROUND

On 27 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of \$130.00 must be provided. Applicants were given two months to respond.

On 22 November 2006, applicants submitted a response which was accompanied by, *inter alia*, the subject petition; a declaration signed by three of the four co-inventors; a "Declaration of Cinzia Trantino" ("Decl."); the petition and surcharge fee; a five-month extension and fee; and authorization to charge any additional fee to Deposit Account No. 23-1925.

DISCUSSION

Petitioners claim that Mr. Mark McDougall "refuses to execute a declaration" in the above-captioned application. Thus, a petition under 37 CFR 1.47(a) was submitted in response to the Form PCT/DO/EO/905 mailed 27 April 2006.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application or cannot be located; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint

inventor on his behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the \$200.00 petition fee has been charged to counsel's Deposit Account as authorized.

With regard to item (3), the 37 CFR 1.47(a) applicants listed the last known address of the nonsigning inventor as:

40 Union Street
Windsor, Victoria
Australia

Regarding item (2), applicants provided a declaration by Cinzia Trantino who states that she received an email from the Human Resource Department of Accenture, Australia on 26 October 2006 containing the address of the nonsigning inventor, Mark McDougall. She then attempted to contact Mr. McDougall by telephone that day to no avail. Decl. at ¶ 8. After further attempts proved fruitless, Ms. Trantino states that an investigator went to that address but could not locate anyone at home. Ms. Trantino states that a neighbor indicated to the investigator that Mr. McDougal and family might be on vacation. *Id.* at ¶ 12. Ms. Trantino concludes by claiming that she attempted to contact Mr. McDougall via telephone from 31 October 2006 to 15 November 2006 but each call was unanswered. *Id.* at ¶ 14. No documentary evidence was provided.

This evidence is insufficient to meet item (2) of 37 CFR 1.47(a).

There is no evidence that Mr. McDougall received the documents and is refusing to cooperate. Further, it is not clear if Mr. McDougall is on vacation and only temporarily unavailable, or he has moved again. Nonetheless, the period in question from 31 October 2006 to 15 November 2006 is too short to conclude that the nonsigning inventor cannot be located. Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. . . .

The 37 CFR 1.47(a) applicants will be given an additional two months (with extensions available) to submit an executed declaration by Mr. McDougall, or determine whether Mr. McDougall refuses to cooperate, or show that despite their diligent efforts, Mr. McDougall cannot be located. Copies of any documentary evidence such as copies of the letters mailed, postal receipts etc., **must** be submitted with any renewed petition.

For the reasons listed above, item (2) is not satisfied.

Concerning item (4), petitioners included a declaration signed by three of the four joint inventors listed on the international publication. The nonsigning co-inventor's name, residence, post office address and citizenship are recorded on the declaration.

Regardless, the declaration is unacceptable. Applicants submitted a declaration consisting of one first page, two Page 2's and one Page 3. Applicants must submit a complete copy of each declaration signed by each co-inventor. For this reason, item (4) of 37 CFR 1.47(a) is also not yet satisfied.

Thus, all of the requirements of 37 CFR 1.47(a) are not yet complete.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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